

REMARKS

Claims 1 - 11 remain active in this application. Claims 1 - 4, 8 and 9 have been withdrawn from consideration as being non-elected, with traverse, in response to a requirement for restriction. The specification has been reviewed and editorial revisions made where seen to be appropriate. Claims 1 - 11 have been amended, principally in regard to matters of form. Support for the amendments of the claims, insofar as they are substantive, is found throughout the application and drawings, particularly in Figure 22 and related Figures 11 - 13, 15, 19, 20 and 23 - 25 and the description thereof on pages 18 - 21. No new matter has been introduced into the application.

The Examiner has adhered to the requirements for restriction and election of species. However, the traverse thereof is respectfully maintained for the reasons of record and for the further reasons discussed below.

Specifically, the requirements are in error and improper since they improperly apply the standard of a lack of unity of invention under 35 U.S.C. §371 since a common technical feature of structures for providing features of a midsole and outsole of a shoe as well as the conformation of the throughout holes is, in fact, present in all claims and no lack of unity of invention was indicated in the International Search report. It is respectfully submitted that, as is particularly evident from the Examiner's response to the previously submitted traverse, the Examiner has based the requirements on the assertion that all of the claimed embodiments do not share an identical combination of technical features; a position which is contrary to the proper criterion for finding a lack of unity of invention under 35 U.S.C. §371. The Examiner's attention is respectfully called to M.P.E.P.

Moot →
because
nacle
Final

) that
doesn't
matter

\$1893.03(d) for a discussion of the distinctions between restriction under 35 U.S.C. §371 and 37 C.F.R. §1.499 and normal U. S. restriction practice under 37 C.F.R. §1.141. In this regard, it is also respectfully submitted that the requirements are also incomplete since a finding of lack of unity of invention requires the Examiner to "explain why each group lacks unity of invention with each other group (i.e. why there is no single inventive concept) specifically describing the unique special technical feature in each group" (emphasis added). Moreover, claim 5 even as amended, is generic to most of the identified species.

Moot

Further, it is respectfully submitted that the requirements are in error by failing to identify claims 8 and 9 as linking claims and to act thereon since these claims link the technical features of the midsole and outsole of the shoe to the mold and molding process. Even under U. S. Practice, if either of these claims was found to be allowable, the requirements must be withdrawn. It is respectfully submitted that the present office action is also incomplete for that reason and should be withdrawn in its entirety. Therefore, reconsideration and withdrawal of the requirements for restriction and election and a non-final action considering all claims is respectfully requested.

Claims 5 - 7, 10 and 11 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite. This ground of rejection is respectfully traversed as moot in view of the amendments made above. All claims have been amended in regard to matters of form and definiteness and it is believed that all of the Examiner's criticisms have been fully addressed. If any issue are seen to remain, it is respectfully requested that the Examiner contact the undersigned by telephone at the number given below in order to expeditiously resolve the same.

Claims 5 - 7 and 10 have been rejected under 35 U.S.C. §102 as being anticipated by each of Cohen and Park and claims 5, 6 and 11 have been similarly rejected based on Luthi et al. These grounds of rejection are respectfully traversed, particularly as being moot in view of the amendments made to claim 5, above.

Claim 5 has been amended to recite that the throughout holes have protrusions formed therein formed with the midsole. No such protrusions are taught or suggested by Cohen or Park and even if formations 56 of Luthi et al. are considered to be protrusions, they are formed with the outsole rather than the midsole and extend into the midsole through gaps in the lower surface of the midsole. Therefore, it is clear that none of these reference anticipates any of the claims rejected. Therefore, reconsideration and withdrawal of these grounds of rejection is respectfully requested.

Since all rejections, objections and requirements contained in the outstanding official action have been fully answered and shown to be in error and/or inapplicable to the present claims, it is respectfully submitted that reconsideration is now in order under the provisions of 37 C.F.R. §1.111(b) and such reconsideration is respectfully requested. Upon reconsideration, it is also respectfully submitted that this application is in condition for allowance and such action is therefore respectfully requested.

Further, even as originally filed, it is respectfully submitted that these references do not anticipate or support a conclusion of obviousness as to the claims as originally filed. For example, none of Cohen, Park or Luthi et al. teach or suggest the molding technique, the mold apparatus, formation in a shooting molding or the joining of midsole portions with an outsole. Therefore, it is also respectfully submitted that claims 1 - 4 and linking claims 8 and 9

product.
not
method
claims

would be allowable over the references applied.

A petition for a three-month extension of time has been made above. If any further extension of time is required for this response to be considered as being timely filed, a conditional petition is hereby made for such extension of time. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-2041 (Whitham, Curtis & Christofferson).

Respectfully submitted,



Marshall M. Curtis
Reg. No. 33,138

Whitham, Curtis & Christofferson, P. C.
11491 Sunset Hills Road, Suite 340
Reston, Virginia 20190

Customer Number: 30743
(703) 787-9400